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In re Application of: :
TOTH, THOMAS L. et al. :
Serial No.: 10/063,420 :
Filed: Apr. 22, 2002 :
Docket: GEMS8081.115 : DECISION ON PETITION
Title: METHOD AND APPARATUS OF :
MODULATING RADIATION :
FILTERING DURING RADIOGRAPHIC :
IMAGING :

This is a decision on the renewed petition filed on Jul. 3, 2008 seeking to withdraw the 37 CFR 1.105 requirement for information made in the Jun. 7, 2006 Office action.. This petition is being considered pursuant to 37 CFR §1.181. No fee is required.

The petition is dismissed as untimely.

The relevant portion of the record shows that:

1. On Jun. 7, 2006, a requirement for information was issued in accordance with 37 CFR 1.105 and MPEP 704.11(a) subsection G. The examiner required the disclosure by the applicant of all co-pending applications and related patents and the identification of specific claims within the co-pending applications and related patents that may present double patenting issues with the present application. This Office action set a shortened statutory period of two months, with extensions of time permitted pursuant to 37 CFR 1.136(a).
2. On Sep. 7, 2006, the applicant submitted a response to the Jun. 7, 2006 Office action with an extension of time. The applicant submitted a list of co-pending applications and related patents. However, the applicant did not identify specific claims that may present double patenting issues and instead argued that the examiner's requirement of the identification of specific claims was improper and overly broad.
3. On Dec. 11, 2006, the examiner responded to the applicant's arguments submitted on Sep. 7, 2006. The examiner used a Notice of Non-Compliant Amendment under 37 CFR 1.121 form and the examiner indicated that the applicant's arguments were non-compliant with the Jun. 7, 2006 Office action. The examiner reiterated the propriety of the Jun. 7, 2006 requirement for information and repeated the requirement for the identification of specific claims within the co-pending applications and related patents that may present double patenting issues with the present application.

4. On Jan. 11, 2007, the applicant submitted additional arguments that the Jun. 7, 2006 requirement for information was improper. The applicant also asserted that the Dec. 11, 2006 response to the applicant's arguments was improper because a Notice of Non-Compliant Amendment under 37 CFR 1.121 form was included in the examiner's response to the Sep. 7, 2006 arguments.
5. On Apr. 11, 2007, the examiner responded to the Jan. 11, 2007 arguments and indicated that the arguments were non-compliant with the Jun. 7, 2006 requirement for information. The examiner repeated the requirement for information and also included a reminder that the time period for response would continue to run from the mail date of the previous Office action, which was mailed Dec. 11, 2006.
6. On May 11, 2007, a petition under 37 CFR 1.181 for review of the Jun. 7, 2006 requirement for information was filed.
7. On Jun. 12, 2007, the present application became abandoned because no compliant response to the Dec. 11, 2006 Office action was received within the six month statutory period.
8. On Nov. 21, 2007, a petition decision for the May 11, 2007 petition was issued and the petition was dismissed. The petition decision also indicated the abandonment of the application as of Jun. 12, 2007.
9. On Jul. 3, 2008, a renewed petition under 37 CFR 1.181 for review of the Jun. 7, 2006 requirement for information was filed.

Analysis and Discussion

In the Jul. 3, 2008 petition, the petitioner asserts that the examiner's use of a Notice of Non-Compliant Amendment under 37 CFR 1.121 form was improper in response to the applicant's Sep. 7, 2006 arguments. The Sep. 7, 2006 arguments were solely arguments in response to the Jun. 7, 2006, a requirement for information was issued in accordance with 37 CFR 1.105 and no amendments were made to the present application. However, as noted in the Nov. 21, 2007 petition decision, an incomplete response to a 37 CFR 1.105 requirement is treated as an amendment under MPEP 704.12(c)¹. Since the Sep. 7, 2006 arguments did not identify specific claims as required by the Jun. 7, 2006, a requirement for information, the arguments were an incomplete response and thus properly handled in the same manner as an amendment.

The petitioner also states that the requirement for information is improper because it requires the applicant to formulate an opinion rather than provide factual information. However, the examiner's requirement for information about specific claims that may present double patenting issues is consistent with the duty of candor required by 37 CFR 1.56. In particular, 37 CFR 1.56(a) states:

The Office encourages applicants to carefully examine....(2)The closest information over which individuals associated with the filing or prosecution of a

¹ MPEP 704.12(c)Treatment of an Incomplete Reply [R-2]

An incomplete reply to a 37 CFR 1.105 requirement in a pending application or reexamination proceeding is handled in the same manner as an amendment not fully responsive to a non-final *>Office< action.

patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

The identification of claims which may raise issues of double patenting required in the Jun. 7, 2006 Office action is material to double patenting considerations and thus is consistent with the above passage of 37 CFR 1.56(a)(2). Further, the relationship between 37 CFR 1.56 and 37 CFR 1.105 is explicitly stipulated in MPEP 704.12(a)². Thus, the Jun. 7, 2006 requirement for information and the Nov. 21, 2007 petition decision were made in accordance with the rules and procedures governing patent examination.

Importantly, the present renewed petition is filed in response to the Nov. 21, 2007 petition decision and thus the filing of the present renewed petition is outside of the two-month time period stated in 37 CFR 1.181(f). Also, as stated in the Nov. 21, 2007 petition decision, the application became abandoned on Jun. 12, 2007 for lack of a proper response to the Dec. 11, 2006 Office action within the statutory period as stated in 37 CFR 1.134.


Conclusion

In view of the record, petitioner's request for withdrawal of the requirement for information issued in the Sep. 7, 2006 Office action is dismissed as untimely for not being filed within the two-month period of 37 CFR 1.181(f).

A petition to revive under 37 CFR § 1.137, including the required fee and a compliant response to the Jun. 7, 2006 requirement for information under 37 CFR 1.105 and MPEP 704.11(a) subsection G should be separately filed and directed to the Office of the Deputy Commissioner for Patent Examination Policy at Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. See MPEP 1002.02.

Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION DISMISSED AS UNTIMELY.


Frederick R. Schmidt, Director
Technology Center 3700

² MPEP 704.12(a)Relationship of Requirement for Information to Duty of Disclosure [R-2]

The duty of candor and good faith under 37 CFR 1.56 applies to the applicant's reply to a requirement for information under 37 CFR 1.105, and requires that the applicant reply to a requirement under 37 CFR 1.105 with information reasonably and readily available.